

Docket No.: PF-0169-2 CON

REMARKS

In the Restriction Requirement, the Examiner requested Applicants to elect one of the following inventions:

Group I (Claims 1, 2, 14, and 15) drawn to a polypeptide;

Group II (Claims 3-5, 7, 9, 10, 43, and 45) drawn to a polynucleotide;

Group III (Claim 8) drawn to an antibody;

Group IV (Claims 11, 12, 25, and 26) drawn to a measuring or testing process involving nucleic acid;

Group V (Claim 13) drawn to a method of preparing a nucleotide involving PCR;

Group VI (Claim 17) drawn to an indeterminate method of detecting an indeterminate agonist activity; and

Group VII (Claim 20) drawn to an indeterminate method of detecting an indeterminate antagonistic activity.

Applicants hereby elect, with traverse, to prosecute Group I, which includes and is drawn to Claims 1, 2, 14, and 15.

Applicants submit that the invention encompassed by the claims of Group II drawn to polynucleotides and of Group III drawn to antibodies, could be examined at the same time as the invention encompassed by the claims of Group I without undue burden on the Examiner. For example, a search of the prior art to determine the novelty of the polypeptides of Group I would provide information regarding the novelty of the polynucleotides of Group II and the antibodies of Group III.

Applicants submit that Claim 17 (Group VI) and Claim 20 (Group VII) are methods of using the polypeptides of Group I, which should be examined together with the polypeptides of Group I, per the Commissioner's Notice in the Official Gazette of March 26, 1996, entitled "Guidance on Treatment of Product and Process Claims in light of *In re Ochiai*, *In re Brouwer* and 35 U.S.C. § 103(b)" which sets forth the rules, upon allowance of product claims, for rejoinder of process claims covering the

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same scope of products. Furthermore, Applicants submit that Claims 11, 12, 25, and 26 (Group IV) and Claim 13 (Group V) are methods of using the polynucleotides of Group II, which should be examined together with the polynucleotides of Group II, per the Commissioner's Notice in the Official Gazette of March 26, 1996.

Applicants further traverse on the grounds that the Examiner could also examine the claims of Group II without undue burden, in view of the fact that they are related to, although of different scope from, claims already allowed in parent application U.S. Serial No. 08/760,745, now U.S. Patent No. 5,972,658. For the Examiner's convenience, those claims are as follows:

1. An isolated and purified polynucleotide sequence encoding the lung growth factor variant (LGVF) having the amino acid sequence of SEQ ID NO:1.
2. A hybridization probe comprising the polynucleotide sequence of claim 1.
3. An isolated and purified polynucleotide sequence comprising SEQ ID NO:2.
4. A polynucleotide sequence which is fully complementary to SEQ ID NO:2.
5. A hybridization probe comprising the polynucleotide sequence of claim 4.
6. An expression vector containing the polynucleotide sequence of claim 1.
7. A host cell line containing the expression vector of claim 6.
8. A method for producing a polypeptide comprising the amino acid sequence of SEQ ID NO:1, the method comprising the steps of:
 - a) culturing the host cell line of claim 7 under conditions suitable for the expression of the polypeptide; and
 - b) recovering the polypeptide from the host cell line culture.

Applicants additionally submit that in any case, there is minimal additional burden on the Examiner to examine the claims of Group II in addition to the claims of Group I, particularly in view of the additional burden on Applicants to file, prosecute and maintain yet additional applications in this family, and respectfully request that the Examiner consider doing so.

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Accordingly, because the search required to identify prior art relevant to the claims of Groups I, II, III, IV, V, VI, and VII would substantially overlap, Applicants respectfully submit that examination of Claims 1-5, 7-15, 17, 20, 25-26, 43, and 45 would pose no undue burden. Thus, Applicants request reconsideration and withdrawal of the Restriction Requirement and examination of Claims 1-5, 7-15, 17, 20, 25-26, 43, and 45. Applicants reserve the right to prosecute the subject matter of non-elected claims, or of any subject matter disclosed but not herein claimed, in a later continuation or divisional application.

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CONCLUSION

In light of the above amendments and remarks, Applicants submit that the present application is fully in condition for allowance. Early notice to that effect is earnestly solicited.

If the Examiner contemplates other action, or if a telephone conference would expedite allowance of the claims, Applicants invite the Examiner to contact the undersigned at the number listed below.

Applicants believe that no fee is due with this communication. However, if the USPTO determines that a fee is due, the Commissioner is hereby authorized to charge Deposit Account No. 09-0108.

Respectfully submitted,
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